

REMARKS

Claims 2, 4-8, 10-12, 14-17, 19-22, 24-26 and 76-84 are presently pending in the current application. Claims 73-75 have been cancelled, claims 2, 4-8, 10-12, 14-17, 19-22, 24-26 and 76-83 have been amended, and new claim 84 has been added in this response.

In the Office Action mailed June 29, 2005, claims 2, 4-7, 10-12, 19, 21, 22, 26 and 73-83 were rejected. More specifically, the status of the claims in light of this Office Action is as follows:

- (A) Claims 4 and 77 were rejected under 35 U.S.C. § 112, second paragraph;
- (B) Claims 4, 12, 22, 26, 73-75, 77 and 83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,789,073 to Fine ("Fine"), U.S. Patent No. 3,514,887 to Jacob ("Jacob"), and U.S. Patent No. 2,984,035 to Nalle ("Nalle");
- (C) Claims 2 and 76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fine, Jacob, Nalle, and U.S. Patent No. 3,338,458 to Hultgren ("Hultgren");
- (D) Claims 5 and 78 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fine, Jacob, Nalle, and U.S. Patent No. 6,015,002 to Biro et al. ("Biro");
- (E) Claims 6, 10, 11, 19, 21, 79, 81 and 82 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fine, Jacob, Nalle, and Official Notice;
- (F) Claims 7 and 80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fine, Jacob, Nalle, and U.S. Patent No. 3,766,116 to Olhoft ("Olhoft");

(G) Claims 4, 22, 26, 73-75, 77 and 83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nalle and U.S. Patent No. 5,968,617 to Jones ("Jones");

(H) Claims 2 and 76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nalle, Jones, and Hultgren;

(I) Claims 6, 10, 11, 19, 21, 79, 81 and 82 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nalle, Jones, and Official Notice; and

(J) Claims 7 and 80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nalle, Jones, and U.S. Patent No. 3,912,100 to Graham et al. ("Graham").

A. Response to the Section 112, Second Paragraph Rejection

Claims 4 and 77 were rejected under 35 U.S.C. § 112, second paragraph. Specifically, the Examiner stated "[t]here is no antecedent basis for the interface region." (Office Action, p. 2.) Claims 4 and 77 have been amended to delete the *interface region* claim feature. Therefore, the Section 112 rejection of claims 4 and 77 should be withdrawn.

B. Response to the Section 103(a) Rejection Over Fine, Jacob and Nalle

Claims 4, 12, 22, 26, 73-75, 77 and 83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fine, Jacob, and Nalle. As described below, Fine, Jacob, and Nalle fail to disclose or suggest all the features of these claims.

1. Claim 4 Is Directed to a Vessel Having a Base Portion, a Wall Portion, and a Background Material, in Which the Base and Wall Portions Are Integrally Formed With Each Other

Claim 4 is directed to a vessel for observing a chemical substance. The vessel includes a base portion, an optically transmissive wall portion projecting away from the base portion, and a background material. The base portion and the wall portion are integrally formed with each other. The base portion has an inner surface and an outer surface. The optically transmissive wall portion has an inner surface, an outer surface,

a first region, and a second region opposite the first region. The outer surfaces of the base and wall portions define an exterior region, and the inner surfaces of the base and wall portions define an interior region. The interior region is configured to contain the chemical substance and has an opening configured to removably receive the chemical substance. The background material has a first surface facing toward the interior region and a second surface facing away from the first surface. The background material is positioned between the inner and outer surfaces of the base portion and the wall portion. The background material is configured so that at least approximately the entire first surface of the background material in the base portion and in the first region of the wall portion is visible through the second region of the wall portion from the exterior region. Accordingly, the background material allows a practitioner to view the chemical substance against the background material without having to separately support and move an adjacent piece of background material, such as a sheet of paper or a paper towel.

2. Fine Discloses a Display Beverage Container Having an Inner Liner Means Received in an Outer Shell Means

Fine discloses a display beverage container 10 including an inner liner means 11 telescopically received in an outer shell means 12. The inner liner means 11 includes an overhanging lip portion 13, a flat bottom surface 16, and converging side walls 15 extending between the lip portion 13 and the bottom surface 16. The outer shell means 12 includes vertical side walls 20 and a bottom surface 21. The side walls 20 and the bottom surface 21 define a hollow interior 23 for receiving the inner liner means 11. Indicia materials 30 can be placed in a display chamber 31 between the inner line means 11 and the outer shell means 12. The overhanging lip portion 13 of the inner liner means 11 selectively engages a corresponding component on the outer shell means 12 to sealably enclose the indicia materials 30. The inner wall means 11 can subsequently be detached from the outer shell means 12 because an "object of the present invention is to provide a beverage container construction enabling facilitated detachment of the components thereof to provide access to the interior of the display chamber." (Fine 1:58-61.)

3. Jacob Discloses a Drinking Glass Having a Slot in the Base for Inserting a Card With Printed Matter

Jacob discloses a drinking glass 10 having an annular wall 12 and a base 14. The base 14 includes a slot 22 for receiving a card 30 with printed matter 32. The base 14 is made of a transparent material so that when the glass is empty, a person can look into the glass 10 and see the printed matter 32. One purpose of Jacob's invention is to encourage children to drink the liquid in the glass. For example, a child that is "unaware of which visual display is present in the base of the glass will then be encouraged to consume the contents of the glass and uncover the transparent bottom through which the visual display card may be viewed." (Jacob 3:9-13.)

4. Nalle Discloses an Ornamental Double-Walled Tumbler

Nalle discloses a tumbler having an outer shell 10, an inner shell 11, an ornamental sheet 15 interposed between the side walls of the outer and inner shells 10 and 11, and a paper disk 12 interposed between the base portions of the outer and inner shells 10 and 11. The tumbler also has a flared upper edge 18 that curves radially outward as it projects away from the base. The ornamental sheet 15 extends from the flared edge 18 to the base all the way around the tumbler. The ornamental sheet 15 and paper disk 12 enhance the heat insulating properties of the tumbler "so that a cold drink stays cold longer, without moisture or dew dripping from its outer walls, while a hot drink stays hot longer, and can be held in the hand without discomfort." (Nalle 2:55-58.)

5. Fine, Jacob, and Nalle Fail to Disclose or Suggest a Vessel Including, *Inter Alia*, a Base Portion, a Wall Portion, and a Background Material, in Which the Base and Wall Portions Are Integrally Formed With Each Other

The combination of Fine, Jacob, and Nalle fails to disclose or suggest a vessel for observing a chemical substance including, *inter alia*, a base portion, a wall portion projecting away from the base portion, and a background material positioned between the inner and outer surfaces of the base and wall portions, "wherein the base portion and the wall portion are integrally formed with each other," as recited in claim 4. The applicant does not concede to the characterization of Fine, Jacob, and Nalle in the

Office Action, but even if Jacob's card 30 were placed in the bottom of Fine's beverage container 10 as suggested by the Examiner, then Fine's container 10 does not include a base portion and a wall portion that are integrally formed with each other. Specifically, assuming for the sake of argument that (a) Fine's side walls 15 of the inner liner means 11 and side walls 20 of the outer shell means 12 correspond to the wall portion of claim 4, and (b) Fine's bottom surface 16 of the inner liner means 11 and bottom surface 21 of the outer shell means 12 correspond to the base portion of claim 4, then Fine's side walls 15 and bottom surface 21 are formed separately, and Fine's side walls 20 and bottom surface 16 are formed separately. Consequently, Fine's base and wall portions are not integrally formed with each other, but rather formed separately and subsequently attached by a user.

Moreover, one of ordinary skill in the art would not be motivated to integrally form Fine's inner liner means 11 and outer shell means 12 because one purpose of Fine's "invention is to provide a beverage container construction enabling facilitated detachment of the components thereof to provide access to the interior of the display chamber." (Fine 1:58-61.) If Fine's inner liner means 11 and outer means shells 12 were integrally formed, the two components could not be detached to provide access to the interior of the display chamber, and one purpose of Fine's invention would be thwarted. Therefore, one skilled in the art would not be motivated to modify Fine's container so that the combination of Fine, Jacob, and Nalle would include all the features of claim 4.

Alternatively, assuming for the sake of argument that Fine's side walls 15, bottom surface 16, and indicia materials 30, correspond to the wall portion, base portion, and background material, respectively, of claim 4, then Fine's indicia materials 30 are not positioned between the inner and outer surfaces of the side wall 15 and the bottom surface 16. Rather, the indicia materials 30 are positioned adjacent to an exterior surface of the side walls 15 and the bottom surface 16. Therefore, Fine's beverage container 10 does not include a background material positioned between the inner and outer surfaces of the base portion and the wall portion as required by claim 4. Accordingly, the combination of Fine, Jacob, and Nalle fails to disclose or suggest all

the features of claim 4. Therefore, the Section 103(a) rejection of claim 4 should be withdrawn.

Claim 12 depends from claim 4. Accordingly, the Section 103(a) rejection of claim 12 should be withdrawn for the reasons discussed above with reference to claim 4 and for the additional features of this claim.

Claims 22 and 26 depend from new claim 84. Accordingly, the Section 103(a) rejection of these claims should be withdrawn for the reasons discussed below with reference to new claim 84 and for the additional features of these claims.

Claims 73-75 have been cancelled in this response and therefore the rejection of these claims is now moot.

Independent claim 77 has, *inter alia*, features generally analogous to claim 4. Accordingly, the Section 103(a) rejection of claim 77 should be withdrawn for the reasons discussed above with reference to claim 4 and for the additional features of claim 77.

Claim 83 depends from claim 77. Accordingly, the Section 103(a) rejection of claim 83 should be withdrawn for the reasons discussed above with reference to claim 77 and for the additional features of this claim.

C. Response to the Section 103(a) Rejection Over Fine, Jacob, Nalle, and Hultgren

Claims 2 and 76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fine, Jacob, Nalle, and Hultgren. Claims 2 and 76 depend from claims 4 and 77, respectively. Accordingly, claims 2 and 76 are patentable over Fine, Jacob, and Nalle for the reasons discussed above with reference to claims 4 and 77 and for the additional features of these dependent claims. Furthermore, Hultgren fails to cure the above-noted deficiencies of Fine, Jacob, and Nalle as references supporting a *prima facie* case of obviousness under Section 103(a). For example, Hultgren fails to provide a motivation to integrally form Fine's side walls 15 and 20 and bottom surfaces 16 and 21. Accordingly, the combination of Fine, Jacob, Nalle, and Hultgren fails to disclose or

suggest all the features of claims 2 and 76. Therefore, the Section 103(a) rejection of claims 2 and 76 should be withdrawn.

D. Response to the Section 103(a) Rejection Over Fine, Jacob, Nalle, and Biro

Claims 5 and 78 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fine, Jacob, Nalle, and Biro. Claims 5 and 78 depend from claims 4 and 77, respectively. Accordingly, claims 5 and 78 are patentable over Fine, Jacob, and Nalle for the reasons discussed above with reference to claims 4 and 77 and for the additional features of these dependent claims. Furthermore, Biro fails to cure the above-noted deficiencies of Fine, Jacob, and Nalle as references supporting a *prima facie* case of obviousness under Section 103(a). For example, Biro fails to provide a motivation to integrally form Fine's side walls 15 and 20 and bottom surfaces 16 and 21. Accordingly, the combination of Fine, Jacob, Nalle, and Biro fails to disclose or suggest all the features of claims 5 and 78. Therefore, the Section 103(a) rejection of claims 5 and 78 should be withdrawn.

E. Response to the Section 103(a) Rejection Over Fine, Jacob, Nalle, and Official Notice

Claims 6, 10, 11, 19, 21, 79, 81 and 82 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fine, Jacob, Nalle, and Official Notice. Claims 6, 10 and 11 and depend from claim 4; claims 19 and 21 depend from claim 84; and claims 79, 81 and 82 depend from claim 77. Accordingly, these claims are patentable over Fine, Jacob, and Nalle for the reasons discussed with reference to their respective independent claims and for the additional features of these dependent claims. Therefore, the Section 103(a) rejection of claims 6, 10, 11, 19, 21, 79, 81 and 82 should be withdrawn.

F. Response to the Section 103(a) Rejection Over Fine, Jacob, Nalle, and Olhoft

Claims 7 and 80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fine, Jacob, Nalle, and Olhoft. Claims 7 and 80 depend from claims 4 and 77, respectively. Accordingly, claims 7 and 80 are patentable over Fine, Jacob, and Nalle

for the reasons discussed with reference to their respective independent claims and for the additional features of these dependent claims. Furthermore, Olhoff fails to cure the above-noted deficiencies of Fine, Jacob, and Nalle as references supporting a *prima facie* case of obviousness under Section 103(a). For example, Olhoff fails to provide a motivation to integrally form Fine's side walls 15 and 20 and bottom surfaces 16 and 21. Accordingly, the combination of Fine, Jacob, Nalle, and Olhoff fails to disclose or suggest all the features of claims 7 and 80. Therefore, the Section 103(a) rejection of claims 7 and 80 should be withdrawn.

G. Response to the Section 103(a) Rejection Over Nalle and Jones

Claims 4, 22, 26, 73-75, 77 and 83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nalle and Jones. For the reasons described below, Nalle and Jones fail to disclose or suggest the features of these claims.

1. Jones Discloses a Glass Having a Substrate Wrapped Around a Side Wall

Jones discloses a glass 8 having a side wall 10 and a background substrate 20 wrapped around an exterior surface of the side wall 10. The background substrate 20 has an opening at one side of the glass 8 and a design 16 on the inner surface of the substrate 20 at the other side of the glass 8. Accordingly, a user can view the design 16 through the opening in the substrate 20.

2. Nalle and Jones Fail to Disclose or Suggest a Vessel Including, *Inter Alia*, a Background Material Configured so That Approximately the Entire First Surface of the Background Material in the Base Portion and in the Wall Portion Is Visible From an Exterior Region

Nalle and Jones fail to disclose or suggest a vessel for observing a chemical substance including, *inter alia*, a "background material being configured so that at least approximately the entire first surface of the background material in the base portion and in the first region of the wall portion is visible through the second region of the wall portion from the exterior region," as recited in claim 4. As the Examiner correctly notes, Nalle "does not teach the second region not having the background or the background being absent from the second region." The Examiner alleges, however, that "[i]t would

have been obvious to employ the opening as taught by Jones in the background of Nalle" so that the user would be able to view substantially the entire background in the bottom or the side. Applicant disagrees.

One of ordinary skill in the art would not be motivated to modify Nalle's tumbler to form an opening in Nalle's ornamental sheet because such a modification would destroy one purpose of Nalle's invention. Nalle states, "[o]ne of the objects of my invention is to provide a tumbler whose walls are heat-insulating." (Nalle 1:16-17.) Nalle explains that the "heat-insulating effect may be enhanced by the interposition of [the ornamental] sheet between shells, since this sheet may be of such a nature as to provide a heat-barrier." (Nalle 2:58-60.) Accordingly, Nalle's tumbler includes an ornamental sheet that extends from the flared edge to the base all the way around the tumbler to thermally insulate the drink in the tumbler, and thereby accomplish one purpose of Nalle's invention. If one were to modify Nalle's tumbler to remove a portion of the ornamental sheet in the side wall, the thermal insulating characteristics of that portion of the side wall would be impaired and one purpose of Nalle's invention would be thwarted. Consequently, one of ordinary skill in the art would not be motivated to modify Nalle's tumbler as suggested by the Examiner. Accordingly, the combination of Nalle and Jones fails to disclose or suggest all the features of claim 4. Therefore, the Section 103(a) rejection of claim 4 should be withdrawn.

H. Response to the Section 103(a) Rejection Over Nalle, Jones, and Hultgren

Claims 2 and 76 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nalle, Jones, and Hultgren. Claims 2 and 76 depend from claims 4 and 77, respectively. Accordingly, claims 2 and 76 are patentable over Nalle and Jones for the reasons discussed with reference to claims 4 and 77 and for the additional features of these dependent claims. Furthermore, Hultgren fails to cure the above-noted deficiencies of Nalle and Jones as references supporting a *prima facie* case of obviousness under Section 103(a). For example, Hultgren fails to provide a motivation to form an opening in Nalle's ornamental sheet. Accordingly, the combination of Nalle,

Jones, and Hultgren fails to disclose or suggest all the features of claims 2 and 76. Therefore, the Section 103(a) rejection of claims 2 and 76 should be withdrawn.

I. Response to the Section 103(a) Rejection Over Nalle, Jones, and Official Notice

Claims 6, 10, 11, 19, 21, 79, 81 and 82 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nalle, Jones, and Official Notice. Claims 6, 10 and 11 depend from claim 4; claims 19 and 21 depend from claim 84; and claims 79, 81 and 82 depend from claim 77. Accordingly, these claims are patentable over Nalle and Jones for the reasons discussed with reference to their respective independent claims and for the additional features of these dependent claims. Therefore, the Section 103(a) rejection of claims 6, 10, 11, 19, 21, 79, 81 and 82 should be withdrawn.

J. Response to the Section 103(a) Rejection Over Nalle, Jones, and Graham

Claims 7 and 80 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Nalle, Jones, and Graham. Claims 7 and 80 depend from claims 4 and 77, respectively. Accordingly, claims 7 and 80 are patentable over Nalle and Jones for the reasons discussed above with reference to their respective independent claims and for the additional features of these dependent claims. Furthermore, Graham fails to cure the above-noted deficiencies of Nalle and Jones as references supporting a *prima facie* case of obviousness under Section 103(a). For example, Graham fails to provide a motivation to form an opening in Nalle's ornamental sheet. Accordingly, the combination of Nalle, Jones, and Graham fails to disclose or suggest all the features of claims 7 and 80. Therefore, the Section 103(a) rejection of claims 7 and 80 should be withdrawn.

K. New Claim 84

Independent claim 84 has, *inter alia*, features generally analogous to claim 4. Accordingly, new claim 84 is patentable over the applied art for the reasons discussed above with reference to claim 4 and for the additional features of new claim 84.

L. Conclusion

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. The applicants accordingly request reconsideration of the application and a Notice of Allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned representative at (206) 359-6465.

Respectfully submitted,

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